Each pending claim describes a novel composition of matter. Therefore, support for a §102 rejection of a pending claim requires citation of a single prior art reference disclosing every element of the claim under consideration. *W.L. Gore & Assoc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). When rejecting the claims under §102, the Examiner must "identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (B.P.A.I. 1990). Further, as stated by the Board in *Ex parte Levy*, "the initial burden of establishing a prima facia basis to deny patentability to a claimed invention rests upon the examiner." 17 U.S.P.Q.2d at 1463-64, citing *In re Piasecki,* 223 U.S.P.Q. 785 (Fed. Cir. 1984). Thus, the burden of comparison does not shift to the Applicants until the Examiner establishes a prima facia basis for the rejection. Finally, as noted by the court in *W.L. Gore & Assoc. v. Garlock, Inc.*, "anticipation of inventions set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references." 220 U.S.P.Q. at 314.

The Applicants have carefully considered the portions of the cited art referenced by the Examiner and each prior art reference in total. However, the Applicants respectfully submit that the cited references fail to describe a cathode material having the physical, chemical and electrochemical properties set forth in the pending claims. Therefore, the cited art does not provide the prima facia basis necessary to support a §102(b) rejection.

In support of the rejection of the claims, the Examiner cited *Ex parte Gray*, 10 U.S.P.Q.2d 1922, 1925 (B.P.A.I. 1989) for the premise "that the burden is on the applicant to show product difference in product comparisons." The *Ex parte Gray* decision concerns a §103 rejection. The court determined that the issue was whether the claimed composition exhibits any unexpected properties compared with that described in the cited art. Id. at 1924.

Clearly the facts of the *Ex parte Gray* decision differ significantly from the facts of the current application. The currently pending claims clearly set forth the unexpected properties of the novel composition as limitations within the claims. Further, the pending application provides clear examples demonstrating the novelty of the current invention when compared to prior art materials. Accordingly, in order to shift the burden of comparison from the Examiner to the Applicants, the Examiner must first establish a prima facia basis for rejecting the claims under §102. *Ex parte Levy*, 17 U.S.P.Q.2d at 1463-64. For the reasons discussed above and in the Applicants' previous responses, the Applicants submit that the Examiner has failed to establish a

prima facia basis for the §102 rejection of the claims. Therefore, the burden of comparison has not shifted to the Applicants at this time.

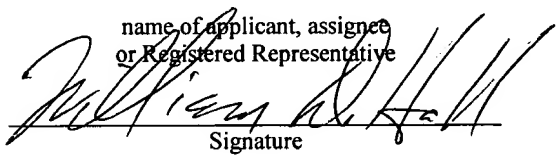
Conclusion

The Applicants have amended the claims in order to place the pending application in condition for allowance. In view of the foregoing arguments over the cited art and the §102 rejection, the Applicants respectfully request that the Examiner reconsider and withdraw the rejection of the pending claims. A formal Notice of Allowance of Claims 17, 18 and 19 is earnestly solicited. Should the Examiner care to discuss any aspect of the foregoing response in greater detail, the undersigned attorney would welcome a telephone call.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail in an envelope addressed to: Mail Stop RCE, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 22, 2003.

WILLIAM D. HALL

name of applicant, assignee or Registered Representative

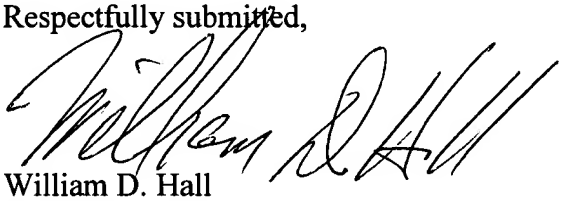


Signature

May 22, 2003

Date of Signature

Respectfully submitted,



William D. Hall
Registration No. 35,535
McAFEE & TAFT
Tenth Floor, Two Leadership Square
211 North Robinson
Oklahoma City, Oklahoma 73102
Telephone: (405)-552-2218
FAX No. (405) 228-7418
E-Mail: bill.hall@mcafeetaft.com

Attorney for Applicants